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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,721	12/10/2003	Alan L. Kriz	38-15(52826)B	9354

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EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/732,721

Applicant(s)

KRIZ ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 2 and 15.  
Claim(s) rejected: 1, 3-14 and 16-18.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☒ Other: See Continuation Sheet.

  
ASHWIN D. MEHTA, PH.D.  
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): the objection to the claim for priority for containing new matter; the rejection of claim 5 under 35 U.S.C. 112, 2nd paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's reply does not overcome the rejection of claims 1-17 under 35 U.S.C. 112, 2nd paragraph, because of the recitation, "emb5" in claims 1 and 14. "Emb5" is an arbitrary designation and can be changed. Further, there is no indication in the specification that maize has only one so-called emb5 gene, making it unclear which emb5 gene is referred to by "the" maize emb5 gene. Applicants point to page 24, lines 7-17 of the specification in support of the recitation, "the maize emb5 gene" (response, page 8, 1<sup>st</sup> full paragraph). However, the first sentence of that passage also recites, "a maize embryo-specific emb5 gene" (emphasis added), indicating that there could be other maize emb5 genes.

The response also does not overcome the rejection of claims 1, 3-14, and 16-18 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, for lack of written description. In response to the Examiner's comment that the specification only describes a maize emb5 gene by its expression pattern, Applicants point to William and Tsang (Dev. Gen., 1994) and William and Tsang (Plant Physiol., 1992) and argue that they contain descriptions of the maize emb5 gene and its expression pattern (response, page 9, last full paragraph). However, William and Tsang (1992) only discloses the cDNA sequence of a maize emb5 gene, and does not discuss the functional activity of its encoded product. William and Tsang (1994) teach the expression pattern of a maize emb5 transcript. William and Tsang (1994) teach that the gene corresponding to that transcript may belong to "class II" type of ABA-inducible genes (page 420) and that the function of the maize class II genes is unknown (page 423). Applicants also argue that the specification provides a working example of isolating a promoter of the invention based on the maize emb5 sequence referenced by its GenBank Accession number (response, page 9, last paragraph). That working example discusses the isolation of SEQ ID NO: 1. The nucleotide sequence of SEQ ID NO: 1 does not identify other maize emb5 genes or their promoters. Further, the specification does not correlate embryo-specific promoter activity with any contiguous 100 nucleotide sequence of SEQ ID NO: 1.

The response also does not overcome the rejection of claims 1, 3-14, and 16-18 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, for failing to enable the full scope of the claimed invention. Applicants argue that the specification provides the nucleotide sequence of a maize emb5 gene which one skilled in the art would know to use in a homology search and clone promoters of identified emb5 homologs (response, page 10, last paragraph). However, one skilled in the art cannot conclude that any other nucleotide sequence is a homolog without knowing the function of the coding sequence naturally operably linked to SEQ ID NO: 1. Applicants indicate that claims 1 and 14 now recite that the promoter is derived from the 5' regulatory region of a maize emb5 gene (response, page 11, 1<sup>st</sup> paragraph). However, again, one skilled in the art cannot identify any other gene, including other maize genes, as an emb5 homolog if one cannot confirm its functional activity.

Continuation of 13. Other: examination of this application has been transferred to Examiner Ashwin Mehta. The art unit, 1638, remains the same.